

Remarks:

Reconsideration of the application is requested.

Claims 1-19 and 21-22 remain in the application. Claims 1, 6, 12, and 19 have been amended. Claim 20 has been cancelled.

In item 1 on page 2 of the above-identified Office action, the Examiner has stated that the drawings have been objected to because in Figs. 1-5 it is unclear as to how the mat 8 is related to the insulating mat 6.

Appropriate correction has been made to the drawings and the specification. The reference sign "8" refers to an inner region of the insulating mat (6) as shown in Fig. 2.

In item 4 on page 2 of the above-identified Office action, the specification has been objected to because of an informality. Appropriate correction has been made.

In item 7 on page 3 of the above-identified Office action, claims 4-5, and 16-17 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

More specifically, the Examiner has stated that the limitation of "long ceramic fibers" is nowhere disclosed in the specification of the priority document (Applicant assumes that the Examiner refers to the instant application by "the priority document").

It is noted that the limitation of "long ceramic fibers" is disclosed on page 13, line 21 of the specification and is shown in Fig. 2 by reference sign "10".

In item 8 on page 3 of the above-identified Office action, claims 4-5, and 16-17 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

More specifically, the Examiner has stated that it is unclear as to what is intended by "long ceramic fibers" and how long the fibers must be to be considered "long ceramic fibers".

The term "long ceramic fibers" is commonly used and understood by a person skilled in the art. An exact measurement of the length of the "long ceramic fibers" is not required.

In item 10 on pages 3-4 of the above-identified Office action, claims 1-11, 14-17 and 19-20 have been rejected under 35 U.S.C. § 112, as being indefinite under 35 U.S.C. § 112, second paragraph.

More specifically, the Examiner has stated that in claim 1, lines 8-10, it is not clear as to what is intended by "...at a remaining said inner region." The language has been amended to even more clearly define the invention of the instant application.

The Examiner has also stated that in claim 2 the language is directed to method of making which renders the claim vague and indefinite as it is unclear as to what structural limitation applicant is attempting to recite. Applicant respectfully disagrees. The language of claim 2 clearly recites a structure that the insulating mat (7) is formed with a folded thicker region at its border.

The Examiner has further stated that in claim 3, line 3 "low" is a relative term and therefore is vague and indefinite (see claim 15 likewise). Although "low" is a relative term, a person skilled in the art would understand what constitutes low heat conduction and heat convection properties for a ceramic material. In addition, the patentability of the

invention of the instant application does not rest on these properties.

The Examiner has further stated that in claim 4, line 2 "long" is a relative term and therefore vague and indefinite (see claims 5, 16-17 likewise). As already discussed above, the term "long ceramic fibers" is commonly used and understood by a person skilled in the art. An exact measurement of the length of the "long ceramic fibers" is not required.

The Examiner has further stated that in claim 6, line 3, "adjacent cavities" has no clear antecedent basis.

Appropriate correction has been made.

The Examiner has additionally stated that in claim 19, line 1, "1" should be changed to --12--. Appropriate correction has been made.

It is accordingly believed that the claims meet the requirements of 35 U.S.C. § 112, first and second paragraphs. Should the Examiner find any further objectionable items, counsel would appreciate a telephone call during which the matter may be resolved. The above-noted changes to the claims are provided solely for cosmetic and/or clarificatory reasons. The changes are neither provided for overcoming the prior art

nor do they narrow the scope of the claims for any reason related to the statutory requirements for a patent.

In item 12 on pages 4-5 of the above-mentioned Office action, claims 1-3, 7-8, 12-15, and 19-20 have been rejected as being anticipated by Locker et al. (US Pat. No. 6,077,483) under 35 U.S.C. § 102(b).

The rejection has been noted and claims 1 and 12 have been amended in an effort to even more clearly define the invention of the instant application. Support for the changes is found on page 11, lines 5-6 of the specification.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1 and 12 call for, inter alia:

the compensating layer being wound around the honeycomb element. (Emphasis added.)

Locker et al. disclose a honeycomb substrate core section 10 that is a substrate skin 12 typically composed of the same material as the core or core section (see column 3, lines 50-57). Disposed on that substrate skin is a porous ceramic barrier coating 14. it is furthermore described in the examples in Locker et al. how the barrier coating is applied to the substrate skin 12. According to example 1, the barrier coating is applied by brushing the ceramic substrate with a coating material such as cordierite powder or the like (see column 6, lines 4-6), which means that the porous ceramic barrier coating 14 integrally connected with the honeycomb element. Such ceramic barrier integrally connected to the honeycomb body cannot be wound around the honeycomb body.

Clearly, Locker et al. do not show the compensating layer being wound around the honeycomb element, as recited in claims 1 and 12 of the instant application.

Claims 1 and 12 are, therefore, believed to be patentable over Locker et al. and since claims 2-3, 7-8, 12-15, and 19 are ultimately dependent on claims 1 or 12, they are believed to be patentable as well. Claim 20 has been cancelled.

In item 16 on pages 6-7 of the above-mentioned Office action, claims 4-5 and 16-17 have been rejected as being unpatentable

over Locker et al. in view of Merry (US Pat. No. 4,929,429) under 35 U.S.C. § 103(a).

As discussed above, claims 1 and 12 are believed to be patentable over the art. Since claims 4-5 and 16-17 are ultimately dependent on claims 1 or 12, they are believed to be patentable as well.

In item 17 on page 7 of the above-mentioned Office action, claims 6 and 18 have been rejected as being unpatentable over Locker et al. in view of Ten Eyck (US Pat. No. 4,999,168) under 35 U.S.C. § 103(a).

As discussed above, claims 1 and 12 are believed to be patentable over the art. Since claims 6 and 18 are dependent on claims 1 or 12, they are believed to be patentable as well.

In item 18 on pages 7-8 of the above-mentioned Office action, claims 9-11 and 21-22 have been rejected as being unpatentable over Locker et al. in view of Santiago et al. (US Pat. No. 4,344,922) and Ten Eyck under 35 U.S.C. § 103(a).

As discussed above, claims 1 and 12 are believed to be patentable over the art. Since claims 9-11 and 21-22 are ultimately dependent on claims 1 or 12, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-19 and 21-22 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate a telephone call so that, if possible, patentable language can be worked out.

Petition for extension is herewith made. The extension fee for response within a period of one month pursuant to Section 1.136(a) in the amount of \$110.00 in accordance with Section 1.17 is enclosed herewith.

If an extension of time for this paper is required, petition for extension is herewith made. Please charge any fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner and Greenberg, P.A., No. 12-1099.

Respectfully submitted,



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